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FAX MESSAGE

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Date: Tuesday, November 18, 2003

Subject: **Application No. 09/826,710 (Attorney Docket No. JP920000136US1)**

To: Supervisor Alford Kindred

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Voice: 703-305-3802

From: Anthony England

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Voice: 512-477-7165

Thank you for responding to the message I left for you today. I will look forward to our telcon coming up on Thursday regarding next steps for the subject case. Enclosed for your information is a Summary of telephone communications and an Applicant Initiated Interview Request Form, submitted 7/15/03. I wanted you to see this so you could understand the context of my request that the case be disposed of without requiring an appeal or continued examination.

CONFIDENTIALITY NOTICE

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Summary of telephone communications with Examiner Ehichioya and Supervisor Vu regarding application 09/826,710

On July 11th, Attorney requested by telephone that Examiner permit Attorney to facsimile transmit a draft reply to the first Office action as a basis for an interview. Examiner indicated that he felt there was not sufficient time remaining to permit receiving a facsimile transmitted draft reply and conducting the interview before the shortened statutory response period, which was due to expire 13 days later. Consequently, Attorney submitted a formal Reply, including amendments to the claims intended to distinguish the invention from the cited art, on about July 15th with a written request for interview, proposing a telephone interview at a certain time on July 29th. Included with the reply was an Information Disclosure Statement ("IDS") and a copy of a co-pending application for examination, together with the appropriate fee payment.

On July 29th Attorney called Examiner at the requested time, however Examiner indicated that he had only just received on the previous day Applicant's reply, which was mailed July 15th. Moreover, Examiner indicated that it would take about five additional weeks to retrieve the file of the co-pending application at the Patent Office. Attorney understood from this telephone conversation that Examiner would contact Attorney to schedule the requested interview before the next Office action once Examiner had obtained the file.

In spite of Attorney's request for an interview and Examiner's agreement in principle, an Office action was issued dated October 1st finally rejecting all claims.

The rejection is based upon 35 USC 103, but relies upon a single reference in the rejection of independent claims. The first Office action relied upon the same reference, but was based upon 35 USC 102. The reply to the first Office action amended the independent claims to overcome the reference.

The Office action did not provide an opinion as to relevance or effect of the co-pending application, if any.

Attorney spoke with Examiner by telephone on October 7th.

In that telephone conversation Examiner indicated it was an oversight that Examiner did not schedule an interview as per the written interview request before issuing the final rejection. Attorney repeated his request for an interview on the substance of the claims with respect to the references cited in the Office actions and requested that the co-pending application submitted in the July 15th IDS be examined. Examiner indicated that the Office had not been able yet to deliver to him the file for the submitted reference. The Office action of October 1st was issued without examining the reference due to Patent Office performance metrics.

Attorney requested that the Office action of October 1st be made non-final until such time as the requested interview is conducted and a written opinion is issued in view of the submitted reference. Otherwise, a fee is imposed upon Applicant for Continued Examination in order to obtain the previously paid for and duly requested interview and examination of the reference.

Examiner consulted with his supervisor and advised later the same day or the next, however, that he was unable to obtain authorization to withdraw the finality of the rejection. Attorney took this decision into advisement and indicated that he would wait a bit and consider next steps.

Summary of telephone communications with Examiner Ehichioya and Supervisor Vu regarding application 09/826,710

On October 20, 2003 Attorney again requested an interview. Examiner stated that he would retrieve the file and call back.

On October 24th Examiner left a telephone message for Attorney indicating that Examiner had retrieved the file but that he would be out the next week. Attorney responsively returned the telephone call and left a message for Examiner stating that Attorney is available, ready, willing and able to conduct the interview immediately or at such a time and as is convenient for Examiner. Examiner called back and stated that he still needed to secure a time for availability of his Supervisor to participate in the interview, and stated that he would call back once he had obtained secured the time. Examiner called back again later the same day and stated that his Supervisor is not available currently and does not want to conduct the interview without the Examiner, who will be out of the office from October 27th through November 9th.

Attorney requested that Examiner schedule the long ago requested interview at some date certain. Examiner indicated, however, that at this time he was not willing to schedule an interview. Instead, he requested that Attorney call Examiner back on November 10th and remind Examiner to get the file back from Central Records, and then once Examiner had obtained the file yet again he would then call and schedule an interview. Attorney expressed his disappointment at once again being put off and left with no certain schedule for resolving this matter.

On November 3rd, after having consulting with his client, who expressed displeasure with the numerous delays, Attorney called Supervisor Vu and requested again that the final rejection be withdrawn until such time as an interview has been granted and the reference submitted in July has been examined. The Supervisor indicated that she would obtain the file and the file for the pending application that was submitted in July and would call back to schedule an interview. She expressed optimism that the IDS document could be examined and the case might be placed in condition for allowance as a result of an interview so that there would be no need to withdraw the non-final rejection.

On November 10th Examiner Ehichioya called Attorney. Examiner indicated that the reference submitted in July has now been examined, and expressed some concern that there may be a double patenting issue with respect to claim six in the present application vs. claim eight in the cited reference, i.e., Application no. 09/574,152.

Attorney indicated that he would review this matter and would like to schedule an interview. Examiner requested that Attorney submit an Applicant Initiated Interview Request Form. Attorney reminded Examiner that such a written request had been submitted in July, but Attorney agreed to submit a supplement to the request in order to add the double patenting issue to the proposed agenda. Once again, Examiner was not willing in the November 10th telephone call to schedule the interview on a date certain.

On November 11th Attorney submitted a supplement to the Applicant Initiated Interview Request Form of July 15, 2003, and proposed a telephone interview for November 12, 2003 at 3 p.m. Eastern time.

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form

Application No: 09/806,710 First Named Applicant: Bera
 Examiner: F. Ehichioya Art Unit: 2172 Status of Application: First O.A.

Tentative Participants:

(1) Anthony England (2) Fred Ehichioya
 (3) _____ (4) _____

Proposed Date of Interview: 7-29-03 Proposed Time: 11 (AM/PM) Eastern

Type of Interview Requested:

(1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: ☐ YES ☒ NO

If yes, provide brief description: _____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>Rejection, claims 1, 547</u>	<u>5,884, 303</u>		<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) <u>Rejection cl. 1-7</u>	<u>"</u>		<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) <u>"</u>	<u>cl. 2-446</u>	<u>5,694, 593</u>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Continuation Sheet Attached

Brief Description of Arguments to be Presented:

1. References concern a different problem. 2. References do not suggest "minimal portion" as claimed.

An interview was conducted on the above-identified application on _____.

NOTE:

This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Anthony England
 (Applicant/Applicant's Representative Signature)

 (Examiner/SPB Signature)

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.